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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,554	01/18/2001	Patrick M. Alliel	200936USPCT	1650

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EXAMINER

BROWN, STACY S

ART UNIT	PAPER NUMBER
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1648

18

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,554

Applicant(s)

ALLIEL ET AL.

Examiner

Stacy S Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-56 is/are pending in the application.
- 4a) Of the above claim(s) 39,40 and 44-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38 and 41-43 is/are rejected.
- 7) ☒ Claim(s) 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment filed March 19, 2003 is acknowledged and entered. Claims 38-56 are pending. Newly submitted claims 39, 40 and 44-56 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims are drawn to sequences and/or methods that were originally restricted out in the Office Action dated August 5, 2002. Claims 38 and 41-43 are examined on the merits with regard to SEQ ID NOS: 1, 3 and 61.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39, 40 and 44-56 are withdrawn from consideration as being directed to a non-elected inventions. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 38 and 41-43 are examined on the merits.

Claim Objections

2. Claim 41 is objected to for having a grammatical error in line 2: "is" should be deleted.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38 and 41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- Claim 38, it is unclear if the polynucleotide fragment (that is at least 80% homologous to at least 190 consecutive nucleotides of SEQ ID NO: 1) is homologous by percentage only, or also in consecutive nucleotides. The polynucleotide fragment could be homologous in scattered positions in the sequence (not necessarily consecutive nucleotides), or it could be homologous consecutively.
- Claim 38, line 3, “said sequence” is unclear. The Office’s interpretation of claim 38 is as follows: There are three levels of sequence in the product of claim 38.
 1. A purified polynucleotide comprising
 2. A sequence containing
 3. A polynucleotide fragment.

Which sequence is being referred to, the purified polynucleotide, the sequence or the polynucleotide fragment? The Office has interpreted “said sequence” to refer to the polynucleotide fragment. Clarification is requested.

- Claim 38, it is unclear how the polynucleotide fragment can be 80% homologous to 190 nucleotides of SEQ ID NO: 1 and at the same time also be a complement or a reverse complement to one of SEQ ID NOS: 1, 3 and 61.
- Claim 43, it is unclear how the sequences relate to each other. The Office’s interpretation of claim 43 is as follows: There are two levels of sequence in the product of claim 43.
 1. A polynucleotide having
 2. A sequence (SEQ ID NO: 1, 3, or 61)

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The claim says that the polynucleotide is selected from a narrow range within SEQ ID NO: 3, yet the sequence contained in the polynucleotide is broad because it is SEQ ID NO: 3 in its entirety. Clarification is requested.

Claim Rejections - 35 USC § 102

4. The rejection of claim 3 is moot in view of Applicant's amendment canceling claim 3. However, claims 38 and 41-43 are rejected under 35 U.S.C. 102(b) as anticipated by Pauley and Waterston for reasons of record. Since the meaning of the claims is unclear and no function has been assigned to the polynucleotides being claimed, the rejection is maintained until further clarification is provided.

Conclusion

5. No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 308-4426. All Group 1600 Fax machines will be available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stacy S. Brown, whose telephone number is (703) 308-2361. The Examiner can normally be reached on Monday through Friday from 6:30 AM-4:00 PM, (EST). If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (703) 308-4027. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SLB

Stacy S. Brown
May 12, 2003



JEFFREY STUCKER
PRIMARY EXAMINER